

## REMARKS/ARGUMENTS

The rejections presented in the Office action dated January 12, 2005 have been considered. Claims 1-30 remain pending in the application. The allowance of Claims 10-16 is acknowledged. The allowability of Claims 4-7, 20-23, and 28 objected to by the Examiner is also acknowledged. Claims 1-3, 8, 9, 17-19, 24-27, 29, and 30 stand rejected. Reconsideration and allowance of the application are respectfully requested.

Claims 1, 8, 9, and 25 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,731,871 issued to *Kitani et al.* (hereinafter *Kitani*). Claims 1-3, 8, 9, 25-27, 29, and 30 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,486,726 issued to *Worley, Sr. et al.* (hereinafter *Worley*). Claims 1-3, 8, 9, and 25-27 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2004/0195978 published for *Horiuchi et al.* (hereinafter *Horiuchi*).

Applicant has elected to further prosecute claims directed to the allowed and allowable subject matter indicated by the Examiner in the Office Action. In particular, Claim 1 has been amended to include the limitations of allowable Claim 4. Claim 25 has been amended to include the limitations of allowable Claim 28 and intervening Claims 26 and 27. Claim 29 has been amended to delete the original elements recited therein and incorporate the elements of allowable Claim 10 redrafted as means plus function elements.

Applicant respectfully requests withdrawal of the anticipation rejections of Claims 1-3, 8, 9, 25-27, 29, and 30. Applicant believes Claims 1-3, 8, 9, 25-27, 29, and 30 are in condition for allowance.

It is to be understood that Applicant's election to further prosecute claims directed to the allowed and allowable subject matter indicated by the Examiner does not constitute acquiescence to the Examiner's rejection of the claims on substantive art grounds. In particular, Applicant does not acquiesce to the Examiner's characterization of the asserted art or Applicant's claimed subject matter, nor of the Examiner's application of the asserted art to Applicant's claimed subject matter. Applicant reserves the right to address the Examiner's characterizations and rejections when prosecuting the rejected claims in one or more continuing applications.

Claims 17-19 and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,116,512 issued to *Dushane et al.* (hereinafter *Dushane*) in view of *Horiuchi*.

To establish *prima facie* obviousness of Applicant's claimed invention, the Examiner has the burden of proving that three basic criteria are met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. All three of these criteria must be met in order to support a finding of *prima facie* obviousness of a claimed invention (*see, e.g.*, MPEP § 2142).

*Dushane*, at column 5, lines 50-55, teaches that the receiver/controller electronics 28 are preferably powered by a power source (VCC) 108 derived from whatever alternating-current power source (e.g., 110 VAC) is available at the region to be controlled and may also include batteries as an alternative or supplemental power source. *Dushane*'s device assumes the availability of adequate power, such as that provided by household 110 VAC power lines.

Clearly, *Dushane*'s teachings on implementing a thermostat system do not contemplate the need nor desire for an LCD backlight system that utilizes LEDs in circuits operating with power supply levels less than the forward voltage requirements of the LED. Instead, *Dushane* would appear to teach quite the opposite.

Applicant can find no suggestion or motivation to modify *Dushane* in the manner suggested by the Examiner or to combine the teachings of *Dushane* and *Horiuchi*. The Examiner contends that *Dushane* could be modified to include the LCD backlight system comprising a voltage booster taught by *Horiuchi* for the generalized objective of allowing the use of low voltage ICs and minimization of power consumption. *Dushane*, however, is unconcerned with power consumption, as its thermostat system operates from household power, a virtually unlimited source of power made available to the *Dushane* system.

Respectfully, the motivation proffered by the Examiner required to support the asserted combination of *Dushane* and *Horiuchi* is not found in *Dushane* or otherwise. One skilled in the art would not be motivated to combine *Dushane* and *Horiuchi*, as this would

needlessly complicate a digital thermostat system design that is powered from 110 VAC with circuitry needed for a low power LCD backlight system.

It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown, and that this evidence be “clear and particular.” *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of references, standing alone, are not evidence. *Id.* Respectfully, no such clear and particular evidentiary showing of a suggestion, teaching or motivation to combine *Dushane* and *Horiuchi* has been established.

Applicant respectfully asserts that *prima facie* obviousness of Applicant’s claims 17-19 and 24 has not been established. Accordingly, Applicant requests withdrawal of the rejection of claims 17-19 and 24.

Without acquiescing to the Examiner’s characterization of the asserted references as applied to Applicant’s dependent claims 18, 19, and 24, Applicant believes it unnecessary to address each specific ground for rejection of every dependent claim in view of the clear grounds for patentability of the claims from which they respectively depend. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. “If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending there from is nonobvious.” M.P.E.P. §2143.03; citing *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicant, however, reserves the right to address these rejections should the Examiner maintain the rejection of base claim 17, notwithstanding Applicant’s remarks presented hereinabove.

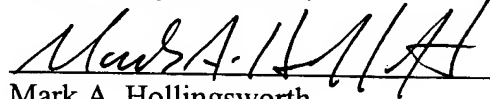
### CONCLUSION

Applicant respectfully submits that the pending claims are patentable over the cited prior art of record, and that the application is in condition for allowance. If the Examiner believes it necessary or otherwise helpful, the undersigned attorney of record may be contacted at 651-686-6633 (x104) to discuss any issues related to this case.

Date: May 12, 2005

By

Respectfully submitted,



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